PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: CHRISTIAN BIERMANN, et al.	Docket: ANO 5980 P1US/0145
Serial No.: 09/720,056	Examiner: Rachel F. Gorr
Filing Date: February 13, 2001	Group Art Unit: 1711
For: IONIC POLYURETHANES	

Assistant Commissioner for Patents
Washington, D.C. 20231

CERTIFICATE OF MAILING

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on April 25, 2003

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SUBMISSION UNDER 37 C.F.R. §1.114

In further response to the Office Action of December 10, 2002, the following remarks are submitted to place the application in condition for allowance.

REMARKS

In the application, claims 1-18 are pending. Claims 1-10 are allowed. Claims 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schurmann (U.S. Patent No. 4,096,127). This rejection is respectfully traversed.

Rejected claims 11-18 of the present invention are directed to charged polyurethanes obtained by the process of allowed claim 1, an aqueous dispersion containing such charged polyurethanes, and a method of surface treating a material in sheet or web form with a composition containing such charged polyurethanes.

The patentability of a product-by-process claim is based on the product itself and does not depend on its method of production. MPEP §2113. The burden is on the Patent Office to show that the claimed product appears to be the same or similar to that of the prior art product. Id. This burden has not been met.

It is alleged in the Office Action that the present invention would have been obvious in view of the product disclosed by Schurmann. Specifically, the Office Action states that Schurmann differs from the claims "by not requiring the presence of the triol and by showing the reaction of the second alcohol as taking place with the isocyanate first rather than in the order specified by the claims", but that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the triol component because Schurmann teaches this for providing some cross-linking, which would make a stiffer, more rigid polymer for those applications in which this property is desired" and that "the order in which the alcohols are reacted with the isocyanate component wouldn't be critical or make much difference in the structure of the product". Applicants disagree.

Schurmann does not teach, suggest or disclose the use of a triol component to provide "*some* cross-linking (emphasis added)". In fact, Schurmann teaches away from the use of a triol component by cautioning against the use of a triol since "*uncontrollable* crosslinking can easily occur in polyisocyanates when 3 or more isocyanate functions in the molecule are used extensively, or in a high proportion (Col. 4, lines 8-11, emphasis added)". Even if, in arguendo, Schurmann suggests the combination recited in the claims, this is not enough. There must also be some reasonable expectation of success for the suggested combination. MPEP §2141. Obviousness does not require absolute predictability, but at least some degree of predictability is required. MPEP §2143.02. One skilled in the art could not have a reasonable expectation of success in using the triol when Schurmann itself sets forth the potential uncontrollability of the resulting cross-linking if a triol is used. If the cross-linking is uncontrollable, it cannot be considered predictable.

With regard to the order of the reactions, Schurmann does not teach, suggest or disclose that the order in which the alcohols of Schurmann are reacted with the isocyanate component "wouldn't be critical or make much difference in the structure of the product" (page 3 of the Office Action). The use of Applicant's disclosure as evidence of this premise is improper. Under 35 USC 103, Applicant's disclosure cannot be used as prior art to support an obviousness rejection.

Thus, for the reasons set forth above, the present invention is both novel and non-obvious in view of the cited document.

The Applicants respectfully request that the Examiner reconsider the rejection of claims 11-18 and find the claims in condition for immediate allowance.

In accordance with Section 714.01 of the M.P.E.P., the following information is presented in the event that a call may be deemed desirable by the Examiner:

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Respectfully submitted,

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